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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/517,366	03/02/2000	Jeffrey S Barber	10970975-1	4565

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EXAMINER

OPIE, GEORGE L

ART UNIT PAPER NUMBER

2194

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/517,366	Barber et al.	
	Examiner	Art Unit	
	George L. Opie	2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ☐ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-20 and 31-37 is/are allowed.
- 6) ☒ Claim(s) 21-30 and 38-40 is/are rejected.
- 7) ☐ Claim(s) ☐ is/are objected to.
- 8) ☐ Claim(s) ☐ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ☐ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ☐ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ☐.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- | | |
|--|--|
| 14) <input type="checkbox"/> Notice of References Cited (PTO-892) | 17) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <input type="checkbox"/> . |
| 15) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 18) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 16) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <input type="checkbox"/> . | 19) <input type="checkbox"/> Other: |

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DETAILED ACTION

This Office Action is responsive to Applicant's amendment and remarks, submitted 13 October 2005.

1. Allowable Subjectmatter

Claims 1-20 and 31-37 are allowable.

2. Claim Rejections - 35 U.S.C. § 101

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 101 that form the basis for the rejections under this section made in this Office action:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

3. Claims 21-30 and 38-40 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Pages 5-6 of Applicant's specification provide guidance as to what Applicant considers to fall within the scope of the phrase "computer-readable medium" as used in currently pending claims 21-30 and 38-40. The pertinent portion of pages 5-6 are as follows:

In the context of this document, a "computer-readable medium" can be any means that can contain, store, communicate, propagate, or transport the program for use by or in connection with the instruction execution system, apparatus, or device. The computer readable medium can be, for example but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation medium. More specific examples (a nonexhaustive list) of the computer-readable medium would include the following: an electrical connection (electronic) having one or more wires, a portable computer diskette (magnetic), a random access memory (RAM) (electronic), a read-only memory (ROM) (electronic), an erasable programmable read-only memory (EPROM or Flash memory) (electronic), an optical fiber (optical), and a portable compact disc read-only memory (CDROM)

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(optical). Note that the computer-readable medium could even be paper or another suitable medium upon which the program is printed, as the program can be electronically captured, via for instance optical scanning of the paper or other medium, then compiled, interpreted or otherwise processed in a suitable manner if necessary, and then stored in a computer memory.

Thus it is clear that while Applicant has not provided an explicit and deliberate definition limiting the phrase "computer-readable medium," Applicant has provided an explicit and deliberate definition of items Applicant intends to fall within the scope of "computer-readable medium." Within this list of items are types of media which would have been recognized by one of ordinary skill at the time of the invention as storage media, propagation or transmission media, and printed matter. It is believed that the types of storage media listed by Applicant would have enabled the recited program logic, when stored thereon, to be read and executed by a computer and realize its functionality. It is likewise believed that the recited propagation or transmission media would enable the functionality to be realized.

Certainly, however, Applicant's inclusion of a piece of paper with the program printed thereon within the scope of "computer-readable medium" indicates the claims are sufficiently broad to read on non-functional descriptive material, printed matter. Printed matter which fails to be functionally interrelated to its substrate has long been held to be nonstatutory.

From MPEP 706.03(a):

For example, a mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955);

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and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967).

As such, claims 21-30 and 38-40 are not limited to embodiments which would enable execution of the program by a computer to realize its functionality and provide a practical application with a useful, concrete and tangible result. Note that any deletions from the specification may raise a question with respect to New Matter.

4. Response to Applicant's Arguments:

During patent examination, the pending claims must be "given their broadest reasonable interpretation **consistent with the specification.**" *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). (emphasis added).

Applicant argues that the claims are statutory because they are directed to a computer readable medium and that, "computer readable medium are [sic] statutory subject matter." This broad-based conclusion lacks support in the court cases cited. A computer readable medium carrying instructions which when executed impart functionality to a computer to cause the computer to perform a practical application with a useful, concrete and tangible result is statutory subject matter.

In this instance, when read in light of Applicant's specification, the claims cover some embodiments where the computer readable medium carries instructions in an executable manner so as to cause such functionality to occur, and they cover nothing more than a piece of paper. Contrary to Applicant's erroneous assertion, the examiner is not reading limitations into the claims from the specification. The examiner is in no way indicating that the computer readable medium is limited solely to the specifically mentioned examples in Applicant's specification. Any equivalents thereto would be established by what is known to those of ordinary skill in the art. Instead, the examiner is basing the rejection on the indisputable fact that Applicant's specification provides clear evidence that Applicant intends for the computer readable medium claims to cover a piece of paper. As indicated in the rejection itself, the courts have long held that a mere arrangement of printed matter, though seemingly a "manufacture," is not patent-eligible. As such, Applicant's arguments are not persuasive. Applicant is again reminded that any changes to the original disclosure, including deletions from the specification, would raise the issue of New Matter.

Applicant's arguments have been fully considered but are deemed to be unpersuasive. For the reasons detailed above, the rejections are maintained as set forth supra.

5. THIS ACTION IS MADE FINAL.

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A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Request for copy of Applicant's response on floppy disk:

Please help expedite the prosecution of this application by including, along with your amendment response in paper form, an electronic file copy in WordPerfect, Microsoft Word, or in ASCII text format on a 3½ inch IBM format floppy disk. Please include all pending claims along with your responsive remarks. Only the paper copy will be entered -- your floppy disk file will be considered a duplicate copy. Signatures are not required on the disk copy. The floppy disk copy is not mandatory; however, it will help expedite the processing of your application. Your cooperation is appreciated.

7. Contact Information:

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private-PAIR or Public-PAIR.

Status information for unpublished applications is available through Private-PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions regarding access to the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

All responses sent by U.S. Mail should be mailed to:

**Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450**

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Hand carried responses should be delivered to the *Customer Service Window* (Randolph Building, 401 Dulany Street, Alexandria, Virginia 22314) and, if submitting an electronic copy on floppy or CD, to expedite its processing, please notify the below identified examiner prior to delivery, so that the Applicant can "handoff" the electronic copy directly to the examiner.

The fax number (571) 273-8300 should be used for all fax transmissions to the Office.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at **(571) 272-2100**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Opie at (571) 272-3766 or via e-mail at George.Opie@uspto.gov. Internet e-mail should not be used where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the Applicant. Sensitive data includes confidential information related to patent applications.


W Thomas
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